

REMARKS

Reconsideration of this Application and entry of the amended claims as presented herein are respectfully requested. Applicants submit that entry of these claims places them in condition for allowance or, if allowance is refused, in better condition for appeal.

The Final Office Action included rejections of claims 1-5, 11+1, 12+2, 14-17, 19, 23, 24, 25, 26+(1, 4, 5, 14, 23), 27+(1, 4, 5, 14, 23), and 28+(1, 4, 5, 14, 23), and indicated that claims 6-10, 26+(6, 9, 10), and 28+(6, 9, 10) are "allowable over the prior art of record."¹ Following entry of the proposed amendments, claims 6-12, 14-17, and 23-28 are pending in the application, with claims 1-5, 13, 18-22, and 29-35 having been cancelled.

Claims 6, 11, 12, 14, 23, 25, 26, and 27 are amended by this response. The amendments to claims 11, 12, 26, and 27 involve removal of dependency from cancelled claims, and it is believed that no support for such an amendment is necessary. To the extent that support for such an amendment is necessary, it is provided by original claims 11, 12, 26, and 27. The amendment to claims 6, 14, and 23 is made for the purpose of clarity, to conform with the examiner's recognition that the prior art does not teach use of such compositions for dust control or soil stabilization. The amendment to claim 14 is supported in paragraphs [0024], [0035], and [0066] as designated in the application as filed. The amendment to claim 23 is supported in paragraphs [0024], [0035], and [0037] as designated in the application as filed. The amendment to claim 25 is made to correct an obvious error in spelling.

¹ Applicants note that while claim 6 is listed as in condition for allowance in the Office Action Summary, it is included in a list of claims rejected based on 35 U.S.C. § 112 in the body of the Final Office Action. There is no elaboration regarding why claim 6 allegedly does not satisfy § 112, and applicants submit that § 112 is indeed satisfied in claim 6 because claim 6 specifies what the effective amount stated therein is effective to do, i.e. dust control and soil stabilization.

Entry of all amendments and allowance of all claims is respectfully requested.

OBJECTIONS AND REJECTIONS

To the extent that the Final Office Action does not repeat the objections and rejections made in the Office Action of March 18, 2005, the Applicants assume that those objections and rejections have been withdrawn. Applicants thank the Examiner for withdrawal of those objections and rejections.

35 U.S.C. § 112, second paragraph. The Final Office Action rejects claims 1-6, 11, 12, 14, 17, 19, and 23-31 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.² In particular, the Final Office Action apparently questions the use of the phrase "an effective amount" in independent claims 1, 14, 23, and 29. Claims 1-5, 19 and 29-31 have been cancelled, claims 11, 12, 26, and 27 no longer depend from claim 1 2, or 5, the phrase no longer appears in claim 14 and its dependent claim 17, and the phrase never appeared in claim 23 or its dependent claims 24-28. The rejection is therefore moot (or was never appropriate) with respect to all of the rejected claims.

Claim 25 is rejected based on the percentage limitations contained therein. The Final Office Action states that it is unclear whether claim 25 further limits claim 23, because claim 23 recites sugar in an amount as high as about 50% by weight, which claim 25 recites salt in an amount up to about 90% by weight. Claim 25 is clear because it is understood that no composition can include dry components in an amount greater than 100% by weight. Therefore,

² The apparent rejection of claim 6 is addressed in footnote 1, *supra*.

one skilled in the art would understand that claim 25 contemplates, for example, a composition including about 5% by weight sugar, about 5% by weight lignin, and about 90% by weight salt. Another composition might include about 40% by weight sugar and about 60% by weight salt. One skilled in the art would recognize the both compositions are within the scope of claims 23 and 25. Claim 25 satisfies the requirements of 35 U.S.C. § 112. The rejection should be withdrawn and the claim allowed.

35 U.S.C. § 102(b). The Final Office Action rejects claims 1, 2, 4, 19, 23, 24, 25, 26+(1, 4, 23), and 29-34 under 35 U.S.C. § 102(b) as allegedly anticipated by United States Patent No. 4,728,393, to Peel (the '393 Patent). The rejection of claims 1, 2, 4, 19, 26+(1, 4), and 29-34 is moot due to cancellation of those claims.

Claims 23, 24, 25, and 26+(23) have been amended to define a method for dust control or soil stabilization comprising applying a composition to an area in need of treatment. The '393 Patent does not teach or suggest use of any composition therein for dust control or soil stabilization. Therefore, the '393 Patent does not include all of the elements of claims 23, 24, 25, and 26+(23). For the '393 Patent to anticipate any claims of the Application, the '393 Patent must include all of the elements of those claims. Because the '393 Patent does not include a method for dust control or soil stabilization, the rejection of claims 23, 24, 25, and 26+(23) under 35 U.S.C. § 102(b) has been traversed.

The Final Office Action rejects claims 29-31 as unpatentable under 35 U.S.C. § 102(b) over U.S. Patent No. 6,468,442, to Bytnar (the '442 Patent). Those claims have been cancelled, and the rejection is moot.

35 U.S.C. § 103(a). The Final Office Action rejects claims 1-5, 11+1, 12+2, 14-17, 19, 23-25, and 26+(1, 4, 5, 14, 23) under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 6,468,442, to Bytnar (the '442 Patent) in view of U.S. Patent No. 4,728,393, to Peel (the '393 Patent). Claims 27+(1, 4, 5, 14, 23) and 28+(1, 4, 5, 14, 23) are rejected under 35 U.S.C. § 103(a) as unpatentable over the '442 Patent in view of the '393 Patent and U.S. Patent No. 5,714,387, to Fowee, *et al.* (the '387 Patent). Claims 27+(1, 4, 23) and 35 are rejected under 35 U.S.C. § 103(a) over the '393 Patent in view of the '387 Patent.

The rejections of claims 1-5, 19, and 35 are rendered moot by cancellation of those claims. The rejections of claims 11+1, 12+2, 26+(1, 4, 5), 27+(1, 4, 5), and 28+(1, 4, 5) are rendered moot by amendment of those claims to remove dependency from cancelled claims 1, 2, 4, and/or 5.

The rejected and pending claims, which are claims 14-17, 23-25, 26+(14, 23), 27+(14, 23), and 28+(14, 23), should be allowed. As amended, these claims define a method for dust control or soil stabilization comprising applying a composition to an area in need of treatment. None of the cited patents teach a method for use of any composition therein for dust control and soil stabilization. It is well-established that for a claim to be obvious in light of prior art, the prior art must teach or suggest all of the limitations of the claim. Because the art cited in the Final Office Action does not teach or suggest all limitations of claims 14-17, 23-25, 26+(14, 23), 27+(14, 23), and 28+(14, 23), the rejections under 35 U.S.C. § 103(a) should be withdrawn, and the claims should be allowed.

CONCLUSION

Applicants submit that all of the stated grounds of objection and rejection have been properly traversed or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and objections and that they be withdrawn. Applicants further request that the claims be amended as set forth herein, and that all amended claims be allowed. Applicants believe that a full and complete reply has been made to the outstanding Office Action and as such the present application is in condition for allowance.

If the Examiner believes for any reason that personal communication will expedite prosecution of this Application, the Examiner is asked to please to contact the undersigned at the telephone number provided. Prompt and favorable consideration of this Response is respectfully requested.

AUTHORIZATION

It is believed that no extension of time is necessary to make this Response timely. It is also believed that all excess claims fees have been properly calculated and paid. In the event that an extension of time and/or payment of excess claims fees is necessary, kindly deduct the cost for same from Deposit Account No. 02-4553 in the name of Buchanan Ingersoll PC.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Duane A. Stewart III", with a stylized flourish at the end.

Duane A. Stewart III
Reg. No. 54,468
BUCHANAN INGERSOLL PC
One Oxford Centre
301 Grant Street, 20th Floor
Pittsburgh, PA 15219
Telephone: (412) 562-1622
Facsimile: (412) 562-1041

Date: August 2, 2005